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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,374	08/15/2003	Eric Hudak	550270-00003	2568
26711	7590	02/23/2005		
QUARLES & BRADY LLP CITICORP CENTER, 500 WEST MADISON STREET SUITE 3700 CHICAGO, IL 60661-2511			EXAMINER CORRIGAN, JAIME W	
			ART UNIT 3748	PAPER NUMBER

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/642,374	HUDAK, ERIC	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jaime W Corrigan	3748	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to the Amendment filed on 29 November 2004. Claims 1, 6, 9 have been amended. Claim 8 has been canceled. Claims 10-12 have been added. Overall, claims 1-7, 9-12 are pending in this application. The arguments with respect to the references applied in the first Office Action were not deemed persuasive. A Final rejection is set forth below.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagai et al. (PN 6,394,060).

Regarding claim 1 Nagai discloses a crankcase (See Figure 1 (20)) having walls which define an interior volume for containing oil and which define a cylinder ; a piston (See Figure 1 (6)) moveably positioned within the cylinder of the crankcase; a cylinder head (See Figure 1 (4)) having a proximal end fastened to the crankcase, the cylinder head extending laterally outward from the crankcase and terminating at a distal end; a rocker arm cover (See Figure 2 (4a)), fastened to the distal end of the cylinder head, the rocker arm cover defining a cavity therein which forms a valve box (See Figure 1 (15)); a drainback passage (See Figure 1 (40)) interconnecting the interior volume of the

crankcase and the valve box to enable the flow of fluid from the valve box to the interior volume of the crankcase (See Column 4 Lines 44-61); and a check valve (See Figure 1 (41)), disposed within the drainback passage, for allowing the flow of fluid from the valve box to the interior volume of the crankcase and preventing the flow of fluid from the interior volume of the crankcase to the valve box (See Column 4 Lines 57-61).

Regarding claim 2 Nagai discloses the check valve comprises a reed valve (See Figure 1 (41)).

Regarding claim 3 Nagai discloses the check valve comprises a check disk (See Figure 1 (41)).

Regarding claim 4 Nagai discloses the check valve comprises a ball valve (See Figure 1 (41)).

Regarding claim 5 Nagai discloses the drainback passage (See Figure 1 (40)) is formed as an integral part of the cylinder head (See Figure 1 (4)) and the crankcase (See Figure 1 (20)).

Regarding claim 6 Nagai discloses the cylinder head has a first bore (See Figure 1 (15)) formed therethrough extending from the distal end to the proximal end of the cylinder head; the cylinder has a cylinder wall (See Figure 1 (5)), integrally formed in the

one wall of the crankcase; and having an interior surface (See Figure 1 (5)) that communicates with the interior volume of the crankcase and an exterior surface (See Figure 1 (15a)) that engages the proximal end of the cylinder head; and the cylinder wall has a second bore (See Figure 1 (40)) formed therethrough extending from the interior surface to the exterior surface, where it aligns with and couples to the cylinder head bore (See Figure 1 (15)); wherein the first bore and the second bore together define the drainback passage.

Regarding claim 7 Nagai discloses a head gasket (See Figure 1 (3)) disposed between the crankcase (See Figure 1 (20)) and the cylinder head (See Figure 1 (4)), the head gasket having an aperture that is aligned with the first (See Figure 1 (15)) and second (See Figure 1 (40)) bores to allow the flow of fluid therethrough.

Regarding claim 11 Nagai discloses the check valve (See Figure 1 (41)) is configured so that when the crankcase (See Figure 1 (20)) is tipped beyond a predetermined angle, the check valve substantially prevents the flow of fluid from the interior volume of the crankcase (See Figure 1 (20)) to the valve box regardless of a position of the piston (See Figure 1 (6)).

Regarding claim 12 Nagai discloses the check valve (See Figure 1 (41)) allows and prevents the flow of fluid in the drainback passage in response to pressure (See Column 5 Lines 12-20) in the crankcase.

***Allowable Subject Matter***

Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Watanabe (PN 6,213,079), Mitadera et al. (PN 4,688,529), Peng (PN 6,167,990), Kurihara (PN 5,588,408) disclose similar oil drainback systems.

Any inquiry concerning this communication from the examiner should be directed to Examiner Jaime Corrigan whose Carlyle telephone number is (571) 272-4858. The examiner can normally be reached on Monday - Friday from 8:30 a.m. – 6:00 p.m. 2<sup>nd</sup> Friday off.

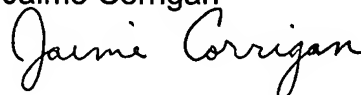
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion, can be reached on (571) –272-4859. The fax number for this group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3700.

JC

Jaime Corrigan



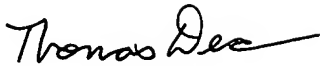
Application/Control Number: 10/642,374  
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February 17, 2005

Patent Examiner

Art Unit 3748

  
**THOMAS DENION**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**